

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

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II. REMARKS

Claims 1 through 35 were originally filed in this application. Claims 36 through 40 were subsequently added. Claims 1, 12, 36, and 40 were previously cancelled without prejudice, and claims 17 through 35 were previously withdrawn with traverse as a result of an earlier restriction requirement. Claims 2, 3, 5-8, 10, 13, 15, 16, 37, 38, and 41 were rejected herein. Claims 2, 3, 7-11, 13, 14, 37, 38, and 41 were amended herein to more clearly define the claimed subject matter and thereby place all of the claims remaining in the application in condition for allowance. Thus, claims 2 through 11, 13 through 16, 37 through 39, and 41 are pending in the present application.

No new matter is presented in the amendments to the claims, and such amendments are deemed unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Interview

Applicant gratefully acknowledges the telephonic interview of November 17, 2006 and appreciates the Examiner's time and consideration. During the interview, pending claims, rejections, and prior art of record were discussed. Applicant's attorney proposed the claim amendments presented herein, and the Examiner indicated that such amendments to the claims would overcome the art cited so far, but that he would need to supplement his search based on such amendments. It was agreed that a Rule 1.111 Reply would be filed including such amendments and the application reconsidered in view of a supplemented search.

B. Allowed Claims

Applicant gratefully acknowledges the Examiner's allowance of claim 39.

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT**C. Claim Rejections Under 35 U.S.C. § 112**

The Office Action rejected claims 7-9, 13-16, 38 and 41 under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled for a link attached to a cross-member or pivotably mounted to a beam. While Applicant is of the opinion that claims 7-9, 13-16, 38, and 41 are in fact enabled as originally filed, Applicant has amended the claims to overcome the rejection. Accordingly, reconsideration and withdrawal of the rejection of claims 7-9, 13-16, 38 and 41 under 35 U.S.C. § 112 is respectfully requested.

D. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 2, 3, 5, and 38 under 35 U.S.C. § 103 as being unpatentable over newly cited U.S. Patent 6,295,682 to Klucznik ("Klucznik") in view of U.S. Patent 6,262,164 to Rivard et al. ("Rivard"). Also, the Office Action rejected claims 2, 3, 6, 7, 10, and 13 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 4,570,388 to Tano et al. ("Tano") in view of Rivard. Further, the Office Action rejected claims 15, 16, 37, and 41 under 35 U.S.C. § 103 over Tano in view of Rivard and further in view of U.S. Patent 3,146,559 to Wilkinson ("Wilkinson"). Applicant respectfully traverses each of the 35 U.S.C. § 103 rejections set forth herein for the reason that Applicant's invention is patentably distinguishable, and not an obvious improvement, over the cited references.

The Office Action does not set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), (a) cited references must teach or suggest all of Applicant's claim limitations, (b) there must be some suggestion to modify or combine reference teachings, and (c) there must be a reasonable expectation of success in modifying or combining the cited references.

Appl. No. 10/628,531

November 17, 2006

Reply to Office Action of August 17, 2006

PATENT**1. Cited References Are Missing Elements Of Applicant's Claims**

Foremost, it is apparent that the cited references do not teach or suggest all of Applicant's claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between Applicant's claims and the individual cited references and any combination thereof, such that all of the claim limitations of Applicant's claims are not met by Klucznik, Rivard, Tano, Wilkinson, or any combinations thereof.

a. Klucznik and Rivard**Claims 2, 3, 5, and 38**

Applicant's amended claims 2, 3, 5, and 38 all now recite, *inter alia*, a plurality of floor finishing units positioned one behind the other in a tandem arrangement in at least one longitudinally extending column on a frame, wherein at least one of the plurality of floor finishing units includes one abrasive grit size different from another abrasive grit size of at least one other of the plurality of floor finishing units. In other words, Applicant's claims recite at least one floor finishing unit equipped with a single abrasive grit of one size, and at least one other floor finishing unit equipped with another single abrasive grit of a different size.

The Office Action generally alleges that Klucznik discloses a power cleaning and sanding machine including a frame 2, a plurality of floor finishing units 30 positioned in a tandem arrangement, and a plurality of links 44, wherein the floor finishing units 30 are pivotably mounted to the frame 2. The Office Action further alleges that Rivard discloses that "a floor finishing unit includes different abrasive grit." (emphasis added) In the Response to Arguments section, the Office Action further alleges that each sander 10 of Rivard has two different abrasive materials and has a coarse grade material on one sander

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

different from a fine grade material on another sander. The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant's claims and any combination of Klucznik and Rivard, as discussed below.

Contrary to the preceding allegations, the Klucznik reference does not, in fact, disclose several of Applicant's claimed elements.

- First, the Klucznik machine does not include a plurality of floor finishing units; rather, Klucznik includes only one power brush assembly.
- Second, of course, the Klucznik single power brush assembly cannot be positioned – in a tandem arrangement with itself – one behind the other in at least one longitudinally extending column.
- Third, as to claim 38 only, the single power brush assembly of Klucznik is not mounted to a frame with a plurality of links; rather, it is mounted to a carriage with one bracket 36.

Also, Rivard does not affirmatively disclose that the nonwoven pad 30 has one abrasive grit size and the sheets 40 have a different abrasive grit size. Rather, this undisclosed improvement is supplied in hindsight with the benefit of Applicant's disclosure. Moreover, the multiple (and not tandem) abrasive assemblies of Rivard have identical abrasive assemblies that do not differ from one abrasive assembly to another.

At best, any combination of Klucznik and Rivard would yield a sanding machine having a single brush assembly, which – somehow – carries a single multi-abrasive assembly composed of two different abrasives (TRIZACT sandpaper pieces supported on a ScotchBrite™ pad). In other words, the combination would yield a single floor finishing unit having only one abrasive assembly. But that is different from Applicant's claimed invention

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

which recites at least one floor finishing unit having one abrasive grit size different from another abrasive grit size of another floor finishing unit.

b. Tano and Rivard

The Office Action generally alleges that Tano discloses a power cleaning and sanding machine comprising a frame and a plurality of floor finishing units 11 mounted to the frame and positioned in a tandem arrangement. The Office Action also alleges that Tano discloses the floor finishing units being adjustable in height with respect to the frame, wherein the frame includes a strut 3, an upright (?) attached to the strut 3, a cross member 4 attached to the strut 3, a beam 16 attached to the strut, and a link 17 attached and mounted to the beam 16. The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant's claims and any combination of Tano and Rivard, as discussed below.

Claims 2, 3, 6, 7, and 10

Applicant's amended claims 2, 3, 6, 7, and 10 all recite, *inter alia*, a plurality of floor finishing units positioned one behind the other in a tandem arrangement in at least one longitudinally extending column on the frame, wherein at least one of the plurality of floor finishing units includes one abrasive grit size different from another abrasive grit size of at least one other of the plurality of floor finishing units. In other words, Applicant's claims 2, 3, 6, 7, and 10 each recite at least one floor finishing unit equipped with an abrasive grit of one size, and at least one other floor finishing unit equipped with another abrasive grit of a different size.

Although Tano may disclose floor finishing units mounted to a frame in a delta pattern, Tano does not disclose that the floor finishing units are positioned one behind the other in a tandem arrangement in at least one longitudinally extending column as

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

recited in Applicant's claims 2, 3, 6, 7, and 10. Rather, the individual floor finishing units of Tano are laterally offset from one another. Thus, Tano teaches the opposite of Applicant's claims 2, 3, 6, 7, and 10.

Also, for at least the reasons already discussed above with respect to claim 2, Applicant's claims 2, 3, 6, 7, and 10 are distinguishable over the Rivard reference.

Claim 13

Applicant's amended claim 13 recites a frame for use in combination with a floor finishing unit, wherein the frame includes at least one strut, at least one upright attached to the at least one strut, at least one cross-member attached to the at least one strut, at least one beam attached to the at least one strut, and at least one link attached to the at least one beam, wherein the at least one link is upwardly and downwardly displaceably mounted to the at least one beam.

Although Tano may disclose a frame with longitudinal and lateral beams 3, 4, Tano does not disclose a link being upwardly and downwardly displaceably mounted to those beams as recited in Applicant's claim 13. Rather, Tano discloses that a holding cylinder 17 is fixed to a holding arm 16, which is fixed to the frame. A fixed link is the opposite from a pivotable link and, thus, Tano teaches the opposite of Applicant's claim 13.

At best, any combination of Rivard and Tano would yield separate, non-tandem, floor finishing units, which are fixed to a frame and each have abrasive assemblies identical to one another.

c. Tano and Rivard and Wilkinson

The Office Action concedes that Tano and Rivard lack a utilities sub-frame having an electrical service box attached thereon and a wheel jack attached to the frame, but alleges that Wilkinson discloses the box 48 and the jack 16. The Applicant respectfully disagrees with

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

the above allegation because there are significant structural and functional differences between Applicant's claims 15, 16, 37, and 41 and any combination of Wilkinson, Rivard, and/or Tano, as discussed below.

Claims 15 and 16

Applicant's claim 15 recites the elements of claim 13, recited above, and a utilities sub-frame attached to the frame and having at least one electrical service box attached thereto. Applicant's claim 16 recites the elements of claim 15 and further recites at least one wheeled jack attached to the at least one upright of the frame.

For at least the reasons already discussed above with respect to claim 13, Applicant's claims 15 and 16 are distinguishable over the combination of the Tano and Rivard references. And Wilkinson does not cure the deficiencies of that combination – with or without an electrical service box or wheeled jack.

Claim 37

Applicant's claim 37 recites a power cleaning and sanding machine including a frame, a plurality of floor finishing units mounted to the frame and positioned one behind the other in a tandem arrangement in at least one longitudinally extending column, wherein at least one of the plurality of floor finishing units includes an abrasive grit size different from another abrasive grit size of at least one other of the plurality of floor finishing units, and at least one electrical service box mounted to the frame, the electrical service box being connected to a power supply cord adapted to be plugged into a power supply outlet, the plurality of floor finishing units being wired directly to and independently controlled by the at least one electrical service box.

Thus claim 37 includes the same limitations of claim 2 previously discussed above in reference to the Rivard and Tano references. Therefore, for at least the reasons already

the deficiencies of that combination – with or without an electrical service box:

Claim 41

Applicant's claim 41 recites a power cleaning and sanding machine for finishing a floor, including a plurality of links movably mounted to a frame, a plurality of floor finishing units pivotably mounted to the plurality of links so as to expose the bottoms of the floor finishing units for servicing thereof, and a jack attached to the frame for adjusting the height of the frame with respect to the floor to be finished to adjust the height of the plurality of floor finishing units.

Again, the Office Action alleges that Tano and Rivard teach Applicant's claim 41 except for a wheeled jack attached to a frame, but alleges that Wilkinson discloses the jack.

But contrary to this allegation, the combination of Tano and Rivard does not, in fact, disclose or teach links movably mounted to a frame. Rather, such combination results in the opposite: a cylinder a holding cylinder 17 fixed to a holding arm 16, fixed to a frame. Fixed is not movable. Again, Wilkinson does not cure the deficiencies of that combination – with or without its electrical service box.

In conclusion, not only do the cited references not meet all of Applicants' claim limitations, in many instances the references essentially teach the opposite of Applicants' claims. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the combination of cited references. See MPEP §§ 2145(X)(D)(1) and 2141.02(VI).

Appl. No. 10/628,531

November 17, 2006

Reply to Office Action of August 17, 2006

PATENT

Therefore, notwithstanding the fact that any combination of the Wilkinson, Tano, Rivard, and Klucznik references as suggested by the Office Action is not legally justified as will be discussed below, Applicant's rejected claims would still have novel and unobvious physical features over the proposed combination. In other words, any attempt at modifying or combining the cited references does not disclose all of the claimed features of Applicant's invention and, therefore, the combination would necessarily constitute a different structure and different result than the claimed invention.

Applicant's claims present unobvious improvement over the cited references and are not obvious modifications or combinations of any of the references of record in this application. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

2. No Basis to Combine the Cited References And No Reasonable Expectation Of Success In Doing So

One of ordinary skill in the art would have no basis for combining the teachings of Wilkinson, Rivard, Tano, and/or Klucznik in order to attempt to replicate Applicant's invention, because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to combine the references," as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). See also *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 51 USPQ2d 1948 (Fed. Cir. 1999). The initial burden to point out the suggestion in the prior art for the desirability of doing what the inventor has done, is on the Examiner. MPEP § 706.02(j) More specifically, the Examiner must set forth the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). The mere fact that references can be

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, the Office Action lacks a proper *prima facie* showing of obviousness since the Office Action does not provide any teaching, suggestion, or motivation for combining the cited references, other than the conclusory statement that "it would have been obvious...in order to provide a simple and versatile arrangement for varying abrasive characteristic to a workpiece." The Office Action neither sets forth any specific proposed modifications of the Wilkinson, Rivard, Tano, and/or Klucznik references necessary to combine them and arrive at the claimed subject matter, nor any principle or specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to combine the references.

Applicants respectfully submit that the Office Action's lack of an indication anywhere in the record of a finding in the cited references of a suggestion for the desirability of the proposed combination, militates against an obviousness rejection of Applicant's invention as claimed.

Furthermore, one of ordinary skill in the art of floor sanding machines would not attempt to combine the references to yield the Applicant's invention in the manner suggested in the Office Action, because the suggested combination is technologically incorrect, and would not result in Applicant's invention without further unsuggested modifications. At best, the suggested combinations would result in a floor finishing machine having a floor finishing unit carrying one abrasive assembly including two different abrading surfaces, but would not result in multiple floor finishing units having abrasive grits sizes different from one another. Simply put, the combinations of references

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

to yield Applicant's invention would be impossible such that a person of ordinary skill in the art would certainly not consider altering or combining the Wilkinson, Rivard, Klucznik, and/or Tano references as alleged in the Office Action.

Notably, the Office Action does not propose any specific modifications of each of the Wilkinson, Rivard, Klucznik, and/or Tano references that would be necessary to successfully combine the references to arrive at the claimed subject matter. Applicants assert that this failure is evidence that such a combination is not reasonably desirable or feasible, which militates against the obviousness rejection of Applicant's invention.

In view of a lack of suggestion from the Office Action and from the cited references, a person of ordinary skill in the art would not seek to modify or combine these references cited in the Office Action to produce the results that Applicant's invention teaches. It is only through Applicant's own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a plurality of floor finishing units positioned in a tandem arrangement on the frame, wherein at least one of the plurality of floor finishing units includes an abrasive grit different from at least one other of the plurality of floor finishing units. In other words, but for Applicant's disclosure, there is no teaching, suggestion, or motivation whatsoever to combine Wilkinson, Rivard, Klucznik, and/or Tano in any way in order to obviate Applicant's invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant's invention after having the benefit of reading Applicant's disclosure. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The teachings or suggestions to make the claimed combination or modification and the reasonable expectation of success must both be found

Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

in the prior art and not based on Applicant's disclosure. *See In re Vaeck*, 20 USPQ2d, 947 F.2d 488, (Fed. Cir. 1991).

III. CONCLUSION

In view of the foregoing remarks, the Applicant respectfully submits that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicant, therefore, respectfully requests that the Examiner's objections and rejections under 35 U.S.C. § 103 be reconsidered and withdrawn and that a formal and timely Notice of Allowance of the application be issued.

Every attempt has been made to place the claims in condition for allowance and it is respectfully asserted that there are no further issues, formal or substantive, that remain for prosecution. Formal allowance of the application is, therefore, respectfully solicited. If the Examiner is not persuaded that all issues are resolved, the undersigned respectfully requests that the Examiner initiate a telephone interview to enable an attempt to be made to resolve any remaining issues. Otherwise, in the event the Examiner is not persuaded of the patentability of the claims he is respectfully requested to enter the amendment for purposes of appeal.

If the Examiner has any questions with respect to any matter now of record, the Applicant's attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 50-0852.

Respectfully submitted,

REISING, ETHINGTON,
BARNES, KISSELLE, P.C.

By 
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Appl. No. 10/628,531
November 17, 2006
Reply to Office Action of August 17, 2006

PATENT

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